

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed June 4, 2004. At the time of the Office Action, Claims 1, 4-7, 9-11, 13-18, 20-21, and 24-30 were pending in the present application. The Examiner rejects Claims 1, 4-7, 9-11, 13-18, 20-21, and 24-30. In this response, Claim 30 has been amended and new Claims 31-34 have been added. For the reasons set forth below, Applicants believe that all pending claims are allowable over the cited references.

Rejections Under §112

The Examiner rejects Claim 30 under 35 U.S.C. §112, second paragraph, relating to the use of the word "or" in the claim. Applicants intended that the three double-indented limitations beginning with "converting" be alternatives (such that only one is required). Applicants have further amended Claim 30 in an attempt to address the Examiner's rejection. Reconsideration and favorable action are respectfully requested.

Rejections Under §103

The Examiner rejects Claims 1, 4-5, 9-11, 13, 16-18, 20-21, 24-25, and 28-29 under 35 U.S.C. §103(a) as being obvious over U.S. Patent 6,449,269 issued to Edholm ("*Edholm*") in view of U.S. Patent No. 6,321,336 issued to Applegate et al. ("*Applegate*"). In addition, the Examiner rejects Claims 6, 14, and 26 under 35 U.S.C. 103(a) as being obvious over *Edholm* in view of *Applegate*, and further in view of U.S. Patent No. 5,896,379 issued to Haber ("*Haber*").

Furthermore, the Examiner rejects Claims 1, 4-5, 9-11, 13, 16-18, 20-21, 24-25, and 28-29 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,272,633 issued to Duke et al. ("*Duke*") in view of *Applegate*. The Examiner also rejects Claims 6, 14, and 26 under 35 U.S.C. 103(a) as being obvious over *Duke* in view of *Applegate*, and further in view of *Haber*.

Finally, the Examiner rejects Claims 7, 15, 27, and 30 under 35 U.S.C. 103(a) as being obvious over either *Edholm* or *Duke* in view of *Applegate*, and further in view of U.S. Patent No. 6,002,689 issued to Christie et al. ("*Christie*").

In order to establish a prima facie case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.¹ Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness at least because the Examiner has not established the first requirement recited above with respect to all of the rejections above. In addition, with at least respect to the rejections including *Duke* as a reference, the Examiner has not established the third requirement recited above.

A. There is No Suggestion, Teaching, or Motivation to Combine *Edholm* and *Applegate*

In the present case, a prima facie case of obviousness cannot be maintained because none of *Edholm*, *Applegate*, or *Haber* provide a suggestion, teaching, or motivation to a person of skill in the art to combine the references to achieve the present invention. *Edholm* discloses data processing in the context of facilitating improved communication between telephony devices. However, *Edholm* does not disclose the need for or the use of its invention for performing address translations. *Applegate* discloses address translations on communications between FTP servers for the purposes of protecting internal networks from external networks. However, *Applegate* does not disclose manipulating telecommunications data or the need for such manipulation, nor does *Applegate* teach or suggest the use of its firewall between telephony devices.

As described in Applicant's previous Response, the M.P.E.P. and Federal Circuit case law support Applicants' position that a combination of references is improper in this case. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill

¹ M.P.E.P. § 2143.

in the art” at the time of the invention.² The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification.³

The governing Federal Circuit case law makes this strict legal standard even clearer.⁴ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.”⁵ “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.”⁶ However, the “range of sources available . . . does not diminish the requirement for actual evidence.”⁷ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.⁸

² M.P.E.P. § 2143.01.

³ *Id.* (emphasis in original).

⁴ Note M.P.E.P. § 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁵ *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

⁶ *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

⁷ *Id.*

⁸ *Id.* (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted); see also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness.⁹

In the most recent Office Action, the Examiner states that “[w]hile Applegate et al does not explicitly mention the need or desire for applying a secure connection between the end members, the examiner believes that it is self evident that people (including one skilled in this art, since nearly everyone communicates using a phone) communicating on opposite ends of a phone conversation almost always desire that their conversation be kept in confidence, such that it would be desirable and perfectly obvious to one of ordinary skill in this art, aware of these two references, to find it obvious to combine them to form a device that is capable of allowing for such a secure conversation.” (Office Action mailed 6/4/04, page 6). However, Applicants submit that the Examiner still has not provided actual evidence of such a suggestion to combine.¹⁰ Simply because the proposed combination would supposedly be helpful is insufficient under the M.P.E.P. and governing Federal Circuit case law. Furthermore, “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.”¹¹ “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.”¹²

Furthermore, the proper inquiry is not whether it would have been obvious to simply provide for a “secure conversation.” There must be a suggestion to combine the references to teach the claimed invention. More specifically, it must be obvious to combine the “address translation” steps of the claims with the “data manipulation” steps. Whether such a combination is obvious is not a question of whether it is obvious to provide a secure

⁹ See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

¹⁰ If the Examiner is relying on “common knowledge” or “well known” art to combine references, the Examiner should provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relied on personal knowledge to supply the required motivation or suggestion to combine the references, the Examiner should provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

¹¹ M.P.E.P. § 2143.01 (citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)).

¹² *Id.* (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

conversation, as implied by the Examiner. Applicants respectfully argue that there is no suggestion to combine *Edholm* and *Applegate* to teach the limitations of independent Claims 1, 10, 18, and 21, and that the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Edholm* and *Applegate* to achieve the Applicants' invention.

For these reasons, Applicants request reconsideration and allowance of Claims 1, 10, 18, and 21 as well as the claims that depend from these independent claims.

B. There is No Suggestion, Teaching, or Motivation to Combine Duke and Applegate

With respect to the combination of *Duke* and *Applegate*, the Examiner states that “[i]t would have been obvious . . . to have provided an additional form of secure communication to Duke et al by hiding the source address, in light of the teachings of Applegate et al, in order to further secure the communication and prevent unauthorized reception of the conversation. (Office Action mailed 6/4/04, page 3). This reasoning is very similar to the Examiner’s reasoning to combine *Edholm* and *Applegate*, as addressed above. For similar reasons to those provided above, Applicants submit that there is no suggestion to combine *Duke* and *Applegate* to teach the limitations of independent Claims 1, 10, 18, and 21, and that the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Duke* and *Applegate* to achieve the Applicants' invention. For these reasons, Applicants request reconsideration and allowance of Claims 1, 10, 18, and 21, as well as the claims that depend from these independent claims.

C. There is No Suggestion, Teaching, or Motivation to Combine Duke or Edholm with Applegate and Christie

Furthermore, with respect to Claims 7, 15, 27, and 30, the Examiner proposes to add *Christie* to the combination of either *Duke* and *Applegate* or *Edholm* and *Applegate* to teach the limitations of these claims. The Examiner states that “[i]t would have been obvious . . . to have provided the intermediary of (Duke et al or Edholm)/Applegate et al with a protocol converter, in light of the teachings of Christie et al, in order to allow the participants in the conversation to

converse over networks of different types.” (Office Action mailed 6/4/04, Page 5). In addition to the *Duke* and *Applegate* or *Edholm* and *Applegate* combinations being improper for the reasons given above, the addition of *Christie* to these combinations is further improper since the Examiner has also not provided any evidence of a suggestion to combine *Christie* with either of these combinations. Again, simply because the proposed combination would supposedly be desirable is insufficient under the M.P.E.P. and governing Federal Circuit case law. Applicants respectfully argue that there is no suggestion to combine these multiple references to teach the limitations of Claims 7, 15, 27, and 30, and that the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of the references to achieve the Applicants' invention. For these reasons, Applicants request reconsideration and allowance of Claims 7, 15, 27, and 30.

D. The Combination of *Duke*, *Applegate*, *Christie* and/or *Haber* Does Not Disclose Each and Every Limitation of the Claims

As described above, the Examiner has combined *Duke* and *Applegate* to reject Claims 1, 10, 18, and 21, and has added *Christie* or *Haber* to this combination to reject certain dependent claims. For example, in the rejection of Claims 1, 10, 18, and 21, the Examiner states that *Duke* teaches a telephony intermediary (encoder 210) that is associated with first and second telephony devices (110 and 150) and that encrypts payload received from the first telephony device and communicates it to the second telephony device. (Office Action mailed 6/4/04, Page 3).

However, Applicants respectfully submit that encoder 210 is not a telephony intermediary and elements 110 and 150 are not telephony devices. More specifically, elements 110 and 150 are “voice sources,” not telephony devices. Furthermore, encoder 210 is not a telephony intermediary between a first and a second telephony device – it is a telephony device. For example, *Duke* states that “voice source 110 provides a voice input for encoder 210. Encoder 210 then processes the voice input to create a secure voice frame for transmission over Internet 50.” (Col. 4, lines 14-17). Similarly, *Duke* also states that “decoder 260 finally converts the digital information into an analog signal with digital-to-analog converter 290. Once the digital information is converted into an analog signal, decoder 260 may then output

the voice output to voice destination 150.” Therefore, encoder 210 the “telephony intermediary” recited in the claims, but instead is simply a digital telephony device that (among other functions) receives and digitizes analog speech for communication on a digital network.

For this reason, *Duke* does not disclose, teach, or suggest a “telephony intermediary” and thus the proposed *Duke/Applegate* combination does not teach each and every limitation of Claims 1, 10, 18, 21 and 30. Therefore, for at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 1, 10, 18, 21, and 30, as well as all claims that depend from these claims.

CONCLUSION

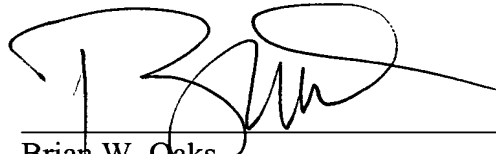
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants submit herewith a check in the amount of \$72.00 to cover the cost of the addition of four (4) dependent claims. The Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS, L.L.P.
Attorneys for Applicants



Brian W. Oaks
Reg. No. 44,981

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Correspondence Address:

Customer No. **05073**